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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,277	07/18/2003	John McGregor	C330.101.101	2411

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EXAMINER	
FU, HAO	
ART UNIT	PAPER NUMBER
3696	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/623,277	MCGREGOR ET AL.	
	Examiner	Art Unit	
	HAO FU	3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,4 and 6-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3, 4, 6-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Argument

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Regarding to claim 1, the applicant amended the independent claim to limit that the funding parties who stand to financially benefit from the initiative, receive benefit only in the form of increase property value nearby the infrastructure. Therefore, new ground of rejection is necessitated. Furthermore, in light of the newly added limitation, claim 4, 6, and 7 are contradictory to the independent claim, because these claims suggest that the funding parties receive benefit from potential saving.

The arguments of the dependent claims have been fully considered, but they are not convincing. The applicant argued some examples of the Official Notice given by the examiner, but the applicant did not challenge the Official Notice. Therefore, the Official Notice is taken as admission of prior art. Even though some examples given by the examiner might not be identical to the claim features, the applicant has not proved that those claim features are not old and well known. The features of the dependent claims are within the common knowledge of one of the ordinary skill in the art. As for claim 9,10, and 11, the applicant merely states that Killick does not teach or suggest a method of having each of the clamed limitations without providing any reasoning.

Claim 2 and 5 are canceled by the applicant.

Claim Rejection – USC 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, 3, 4, 6, 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, claim 1, as amended, teaches that the investors receive benefit from the increase in value of the properties they already own. For example, when a bus/train station is built nearby a community, the community's value increases due to better accessibility. However, claim 4, 6, and 7 disclose that the investors receive benefit from savings made by provision of the initiative. The dependent claims are contradictory to the newly amended independent claim.

Claim 3 recites the limitation "a percentage of the assessed increase in value". Since claim 2 has been canceled by the applicant, and claim 1 does not teach measuring the increase in property value, there is insufficient antecedent basis for this limitation in the claim.

Claim Rejection – USC 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Milwaukee (Transportation Take Realistic Look at Light Rail, Milwaukee Journal Sentinel, May 24, 2002. pg. 18.A).

As per claim 1, Milwaukee teaches a method of funding an infrastructure or building initiative, the method comprising:

collecting payments from parties who stand to financially benefit from the initiative through the increase in value of property other than the infrastructure or building that is created by provision of the infrastructure or building initiative and using these payments to partly or wholly fund the initiative (seepage 1, especially "It has been so successful at boosting property values in Portland that private developers are chipping in millions to help pay for the latest system extension"; developers are the parties who stand to financially benefit from the light rail, because the light rail increase the value of their properties; also developers are the parties which partly fund the infrastructure).

As per claim 12, Milwaukee the parties who stand to financially benefit include landowners and/or developers and/or companies (prior art teaches the developers are the parties who stand to financially benefit).

As per claim 13, Milwaukee teaches the initiative is a transport initiative (see page 1, specifically Milwaukee teaches funding a light rail).

Claim Rejection – USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 3, 8, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milwaukee (Transportation Take Realistic Look at Light Rail, Milwaukee Journal Sentinel, May 24, 2002. pg. 18.A), in view of Official Notice.

As per claim 3, Milwaukee teaches collecting payment from developers, but does not explicitly each payment collected is a percentage of the assessed increase in value.

Official Notice is taken that each payment collected is a percentage of the assessed increase in value is old and well known in the art. Such payment scheme is common in deal negotiation. Furthermore, the amount collected from parties who stand to financially benefit from the initiative has no patentable weight.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include this feature for the benefit of defining a fair payment amount

As per claim 8, Milwaukee does not explicitly teach involving assessing parties that may be interested in providing funds and entering confidential negotiations with those parties.

Official Notice is taken that assessing parties that may be interested in providing funds and entering confidential negotiations with those parties is old and well known in the art. This is a common practice of fund raising.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include this feature for the benefit of raising more funds and protecting the privacy of the investors.

As per claim 14, Milwaukee does not explicitly teach the percentage is a pre-determined percentage.

Official Notice is taken that charging payment at a predetermined percentage is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include this feature for the benefit of defining a fair payment amount.

As per claim 15, Milwaukee does not explicitly teach the percentage is a pre-determined percentage.

Official Notice is taken that charging payment at a predetermined percentage is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include this feature for the benefit of defining the payment amount.

Claim 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milwaukee (Transportation Take Realistic Look at Light Rail, Milwaukee Journal Sentinel, May 24, 2002. pg. 18.A), in view of Killick (Developers Build Rungs at the Bottom of the Ladder, Financial Times, Feb 12, 2003. pg. 04).

As per claim 9, Milwaukee does not teach involving applying for or granting planning permission to build or re-build property in a property up-lift area.

Killick teaches involving applying for or granting planning permission to build or re-build property in a property up-lift area (see title and second paragraph under full text; it is a common knowledge that planning permission is needed before property can be legally built, which is implied by Killick; also see paragraphs starts in the middle of page 2 to the bottom of page 2, it is suggested that the properties are built near the main rail termini, which is a property up-lift area according to applicant's definition).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include applying for or granting planning permission to build or re-build property in a property up-lift area.

One of ordinary skill in the art would have been motivated to modify the reference in order to legalize the construction.

As per claim 10, Milwaukee does not teach the property up-lift area is a pre-defined or designated area in a vicinity of the initiative.

Killick teaches the property up-lift area is a pre-defined or designated area in a vicinity of the initiative (see paragraph starts with "Jonathan Seal, managing director of..." on page 2; Killick discloses that properties are built near the main rail termini, which is a pre-defined area in a vicinity of the initiative).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to define the property up-lift area is a pre-defined or designated area in a vicinity of the initiative.

One of ordinary skill in the art would have been motivated to modify the reference in order to clarify the building site.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milwaukee (Transportation Take Realistic Look at Light Rail, Milwaukee Journal Sentinel, May 24, 2002. pg. 18.A), in view of Dalya Alberge (Theatre to get back its Edwardian glory, The Times, Sep 8, 1994).

As per claim 11, Milwaukee does not explicitly teach the step of collecting payment is done after planning permission is granted to a property developer and the initiative is committed.

Dalya Alberge teaches the step of collecting payments is done after planning permission is granted to a property developer and the initiative is committed (see second last paragraph, "ENO will also raise funds through a Capital Campaign, launched after planning permission is given", prior art clearly teaches that the payment is collected after planning permission is granted).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include the step of collecting payments is done after planning permission is granted to a property developer and the initiative is committed.

One of ordinary skill in the art would have been motivated to modify the reference in order to protect investors.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO FU whose telephone number is (571)270-3441. The examiner can normally be reached on Mon-Fri/Mon-Thurs 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hao Fu
Examiner
Art Unit 3696

JUN-08

/Hao Fu/
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